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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/486,759	06/08/2000	ALBHY GALUTEN	9389/1F215-U	4604
7590	12/21/2005		EXAMINER	
DARBY & DARBY 805 THIRD AVENUE NEW YORK, NY 10022-7513			DONAGHUE, LARRY D	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 12/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/486,759	GALUTEN, ALBHY	
	Examiner	Art Unit	
	Larry D. Donaghue	2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 04 October 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 3-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 3-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

Art Unit: 2154

1. Claims 1 and 2-16 are presented for examination.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Mirashrafi et al (6,199,096) in view of Discussion Paper No. 96.

As to claim 13, Mirashrafi teaches the substantially invention as claimed, including generating a information identifier at a first location where the information identifier identifies a media object (col. 4, lines 9 -10); transmitting the information identifier from the first location to a second location through the network (col. 4, lines 21 - 25); and rendering the identified media object at the second location such that rendition of the media object at the second location is synchronized with the rendition of the media object at the first location (col. 4, lines 29 - 30.)

As to claim 14, Mirashrafi teaches transmitting the information identifier from the second location to a server; at the second location, receiving from the server the media object identified by the information identifier); optionally, displaying the media object at the second location when the media object contains a visual portion; and optionally, producing audio corresponding to media object at the second location when the media object contains an audio portion (col. 4, lines 32 - 34.)

As to claims 15, Mirashrafi teaches an object-id specifying a location of the media object (col. 4, line 12.)

Mirashrafi et al. did not expressly disclose that the information identifier is a handle, rather taught the information identifier is a URL, Discussion Paper No.96, taught that URN (handle) is an improvement on the URL and give supporting rational (see sections 1-2). It would have been obvious to combine these references in view of the express teaching in Discussion Paper No. 96.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mirashrafi in view of Discussion Paper No. 96 as applied to claim 13 above, and further in view of Ogdon et al., U.S. Patent No. 6,161,137.

As to claim 16, Mirashrafi and Discussion Paper No. 96 teach the invention as claimed with respect to claim 13. However, Mirashrafi does not teach computing a transport time as the difference between a current absolute time and an absolute time when the handle was transmitted or at the second location, rendering the media object corresponding a temporal location incremented by the transport time.

Ogdon teaches calculating a transport time (col. 23, lines 6 - 7.)

Although Ogdon does not specifically teach the rendering step, it would have been obvious to one of ordinary skill in the art to combine the teachings of Ogdon and Mirashafri and Discussion Paper No 96, and further to modify the combination to include a rendering step because Ogdon suggests that the delay may be used as a determining factor in how to treat the content (Ogdon, col. 24, lines 28- 32.).

5. Claims 1,3,4 and 6-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoze (A Secure Repository Design for Digital Library) in view of Kahn et al. "A Framework for Distributed Digital Object Services" and "Managing Access to Digital Information".

6. Lagoze taught the invention substantially (claim 1) as claimed, including a method for transmitting media information over a network comprising the steps of: generating a handle at a first location where the handle identifies a media object independent of a location of the media object ; transmitting the handle from the first location to a second location through the network; and rendering the identified media object at the second location in accordance with the handle (page 4, particularly titled Repository).

Lagoze did not expressly teach identifies at least one value-chain participant;. However Kahn et al. taught section 3.2, that other information other than the unique identifier is stored in the handler system, further that the key-metadata includes the handle, applicant usage of handle corresponds to the (key-metadata section 2.2) . It would have been obvious to combine these references as it is expressly suggest by Lagoze.

Neither reference expressly disclosed the content of the key-metadata, "Managing Access to Digital Information" suggest placing identifier for each participant of a value-chain, in the metadata . It would have been obvious to combine these reference as , "Managing Access to Digital Information" states in section 2, that it is a furthering of the work of Kahn et al.

"Managing Access to Digital Information" taught of: obtaining an identifier for the media object; (Section 3.0, section titled Persistent Unique Identifiers and identifier for each participant of a value-chain for the media object (Appendix A , Chain of Operations and Value Management); and combining the identifiers to form the handle.

As to claim 3, Lagoze taught the transmitting step operates to transmit the handle via at least one of: e-mail, chat, instant messaging, internet protocols, cell phone protocols, TV/video links, and dynamic chat (pages 1-12).

As to claim 4, Lagoze taught the steps of: transmitting the handle from the second location to a server ; at the second location, receiving from the server the media object identified by the handle; wherein the rendering step comprises: optionally, displaying the media object at the second location when the media object contains a visual portion; and optionally, producing audio corresponding to the media object at the second location when the media object contains an audio portion (page 2, digital objects page 4, Dissemination).

Art Unit: 2154

As to claim 6, Lagoze taught the handle the handle includes at least an object-id specifying a location of the media object; (page 4).

As to claim 7, "Managing Access to Digital Information" taught the handle additionally includes a set of terms that govern the rendition of the media object (appendix A, section titled Associated terms and conditions).

As to claim 8, "Managing Access to Digital Information" taught the handle additionally includes a reference to a set of terms that governs the rendition of the media object (section 3.0, section titled Metadata Standard).

As to claim 9, Lagoze taught rendering a media object at a first location; generating a handle at the first location where the handle identifies the media object independent of a location of the media object and transmitting the handle to at least one second location over the network; and rendering the media object at the second location using the handle (page 4, particularly titled Repository).

As to claim 10, "identifier for each participant of a value-chain, "the step of rendering the media object at the second location comprises the steps of: obtaining permission to render the media object at the second location from the at least one value-chain participant; rendering the media object at the second location in accordance with such permission (section 3.0, section titled Metadata Standard and Appendix A section Titled Chain of Operation and Value Management).

As to claim 11, Lagoze taught the step of rendering the media object at the second location comprises the steps of: transmitting the handle from the second location to a server; at the second location, receiving from the server the media object identified by the handle; optionally, displaying the media object at the second location when the media object contains a visual portion; and optionally, producing audio corresponding to the media object at the second location (page 2, digital objects page 4, Dissemination).

As to claim 12, Lagoze taught the handle the handle includes at least an object-id specifying a location of the media object; (page 4).

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lagoze (A Secure Repository Design for Digital Library) in view of Kahn et al. "A Framework for Distributed Digital Object Services" and "Managing Access to Digital Information, as applied to claim 1, above, and further in view of Official Notice.

The cited references did not expressly disclose storing the handle locally. However the caching of URL is well known in the art to, improve access throughput so, as not to repeat the URL processing to access the destination, the same would be true of the handle processing.

8. Applicant's arguments filed 10/04/2005 have been fully considered but they are not persuasive.

Specifically, the Examiner states that neither Lagoze nor Kahn disclose "placing an identifier for each participant of a value chain, in the metadata" and that this element is disclosed in Managing Access. Applicants

Art Unit: 2154

respectfully submit that Lagoze teaches away from the concept and neither Kahn nor Managing Access are enabled references and do not teach one of ordinary skill in the art how to make the invention. Both Kahn and Managing Access are, at best, academic theories describing hypothetical systems for securely transferring digital content without any information on how to implement the system.

Regarding Lagoze, the entire disclosure revolves around finding items in a repository, in essence, how to form a digital library. Lagoze's and Kahn's architecture is silent regarding value chain management because they are trying only to form the library and find references. Both are only considering how to allow users to access information from a specific repository. In contrast, the present invention contemplates series of commercial transactions between multiple parties. For example, a provider sends content to a retailer, the retailer sells it to a user and a second user synchronizes their content with the first user. Throughout the transfers of the media object, the value-chain participants remain in control of their content by being compensated for the transactions. Lagoze's and Kahn's architecture does not contemplate these types of transactions, let alone tracking them for additional parties. The above is not contemplated by Lagoze and Kahn and, thus, one of ordinary skill in the art is taught away from an architecture including value chain management.

In Response, examiner has shown express motivation in the references for the combinations.

Applicant argues Regarding Kahn, it is, by its own admission, not enabled to teach one of ordinary skill in the

art even its base teaching. Kahn is replete with comments and language stating that the concepts he discusses have not been designed or tested. For example, on page 2, Kahn begins the discussion of the paper with "[c]onceptually, the System works as follows..." and then on pages 4 and 5, Kahn adds comments for numerous functions that "[w]e leave unspecified at this point how this might be accomplished...;" "[t]he details of interaction with handle generators are left unspecified;" and "[t]he mechanism for this registration is currently unspecified." The above is only a sample of the language that illustrates that Kahn did not enable his concepts and cannot teach one of ordinary skill in the art how to implement his concepts.

Further proof that Kahn is not enabled comes from Lagoze. Lagoze specifically states that:

Researchers from the Digital Library Research Group at Cornell, the Computing and Communications Group at NCSA (University of Illinois), CNRI [Corporation for National Research Initiatives], and Xerox Corporation collaborated over the past several months to develop a design for repositories of objects in digital form, a fundamental component of digital libraries. ... Our starting point for this design is the framework articulated by Robert Kahn (CNRI) and Robert Wilensky (UC Berkeley) [4], as a result of the Advanced Research Projects Agency Computer Science Technical Report Project [5]. This work is commonly referred to as the Kahn/Wilensky architecture.

Lagoze, page 2. Lagoze states above that it took two universities (one an ivy league institution), a not-for profit organization who's stated goal is to "foster research and development for the National Information Infrastructure" and a major corporate entity "several months" to implement a "first stage" design of the concepts outlined by Kahn. Thus, Lagoze informs us that Kahn does not enable

his disclosure and one of ordinary skill in the art is not taught how to make or use what is disclosed.

Additionally, Managing Access also does not enable its disclosure. The disclosure is a White Paper which, like Kahn, discusses what may be in the future without instructing one of ordinary skill in the art how to implement it. Managing Access is especially vague on the element the Examiner contends it discloses, adding value-chain identifiers to the handle. The concept of value-chain management is mentioned mostly in passing and with no framework. For example, in describing digital objects, Managing Access states that "[t]here will probably be at least two different categories of digital objects - those that come with meaningful restrictions and those that do not. Many commercial digital objects may come without any meaningful restrictions; others may be heavily encumbered." Managing Access, page 4 (emphasis added). Further, Managing Access asks numerous unanswered questions relating to the value-chain concept. These questions illustrate that the authors have not enabled the disclosure. Some questions are:

How will network users be able to "borrow" or otherwise use digital objects stored in repositories?
Will there be restrictions on who may access such information? ...

With respect to digital objects, how can we track who owns what and in what contexts? ...

How can information owners be adequately compensated when their works are expressed in various digital formats that may be accessed, manipulated, interpreted, and aggregated where such works are configured as digital objects? ... [and]

Will automated licensing mechanisms be developed within a network environment to facilitate access to digital objects and their contents?

Managing Access, pages, 5-7. Thus, the questions asked indicate that the authors had not enabled the invention for one of ordinary skill. The disclosure indicates that the authors never reduced an enabled version of the concept to practice.

Further, the authors define the state of the art the time they wrote the article and the state of the art does not include identifying value-chain participants. The listed enabled (or still being developed) portion of the disclosure is:

Current technology enables vendors to provide some or all of the following services, several of which are now under development (Bock 1996; IBM infoMarket 1995; and Sibert et al. 1995):

linking content providers to those who want content; providing content or content-related services; acting as a repository for digital objects; providing abstracts and indices; searching

content; employing encryption and related techniques to manage rights and interests and to ensure the integrity of digital objects and their contents; delivering information on disks or CD-ROMs, or providing network access via e-mail, browsers, etc.;

keeping information protected until the digital object is opened (e.g., in order to open an object, the user must contact a clearinghouse to handle the payment); and operating somewhat like a bookstore (e.g., understanding content, generating abstracts, and selling digital objects to the public).

Managing Access, page 10.

Applicants respectfully submit that one of ordinary skill in the art is not taught how to make the invention suggested by Managing Access. Further, Lagoze provides proof that either numerous persons above ordinary skill are required to enable a similar invention or undue experimentation is required. Numerous persons from prestigious organizations over the course of several months were required to produce a first stage design of Kahn's system architecture and this design did not include value-chain identifiers.

In response this is mere speculation, no evidence is supplied to support this position. Argument of attorney can not take the place of evidence.

Applicant argues Furthermore, Applicants submit that Managing Access is actually objective evidence of nonobviousness as describing a "long felt need" in the industry that has not been satisfied. Managing Access outlines what the industry wants and should strive for in the future. Managing Access also admits that the concept is not even in development, let alone enabled, at the time the article was written. In contrast, the present invention enables the concept and provides the industry the long felt solution outlined by Managing Access.

In response this is mere speculation, no evidence is supplied to support this position. Argument of attorney can not take the place of evidence.

Art Unit: 2154

Applicant argues Claims 13-15 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,199,096 to Mirashrafi et al. ("Misashrafi") in view of Discussion Paper 96. Claim 16 is rejected under 35 U.S.C. § 103(a) as obvious over Misashrafi in view of Discussion Paper 96 and further in view of U.S. Patent No. 6,161,137 to Ogdon et al. ("Ogdon"). Applicants respectfully traverse the rejections.

The Examiner contends that Mirashrafi discloses a system that synchronizes the rendition of the media object at the second location with the rendition of the media object at the first location. The Examiner further contends that this is disclosed on column 4, lines 29-30. Applicants respectfully disagree with the Examiner's reading of Mirashrafi. Mirashrafi admits that his synchronization is not truly synchronization. In the same paragraph where the Examiner contends Mirashrafi discloses synchronization, Mirashrafi defines his meaning of "synchronization."

Additionally, it is to be appreciate[ed -sic] that because each synchronization participant is responsible for retrieving the page from the web server, the page will not be displayed at exactly the same time to all synchronization participants. However, it will be displayed at approximately the same time.

Mirashrafi, column 4, lines 32-38 (emphasis added). Thus, the web page transmitted using Mirashrafi's system is not rendered at the first and second location at the same time, there is a time lag. Mirashrafi is not using the ordinary meaning of the word, is aware that his system has this limitation, and provides his definition of "synchronization".

Mirashrafi is incapable of true synchronization. Mirashrafi discloses a bridgeport, which is part of the crux of his invention, to allow for sharing between common clients to a bridge server. Mirashrafi requires a user to access content and transmit the URL of that content to the Bridgeport. The bridgeport then transmits the URL to other clients connected to the Bridgeport and then each client is responsible for retrieving the common content. Applicants respectfully submit that it is impossible to truly synchronize content using Mirashrafi's arrangement due to the inherent delays at every transmission and receiving step outlined above.

In contrast, claim 13 recites the element that "rendering the media object at the second location such that the rendition of the media object at the second location is synchronized with the rendition of the media object at the first location." The Specification defines synchronization as:

The player may also synchronize the rendition of the content at each of the users' locations. Using the supplemental information contained in the Handle, the rendering application, e.g. player, can coordinate playing the same content at the same time and rate at multiple locations. ... For example, assume that the sender and recipient each have the content resident locally and that it takes eight seconds from sending the e-mail until the recipient receives it. The sender begins to play the content and then decides to e-mail the recipient to synchronize playing the content. By the time the recipient receives the e-mail, the sender has experienced eight seconds of the content. Hence the recipient's player will start playing the content an additional eight seconds into the content to that it is perfectly synchronized with the sender's experience of the content.

Art Unit: 2154

Specification, page 3, lines 15-18 and page 10, lines 22-29 (emphasis added). Applicants have solved the problem of true synchronization, whereas Mirashrafi has not. Thus, not only does Mirashrafi not synchronize content as defined in the claim, but admits that his system is incapable of it.

Mirashrafi does not disclose or suggest the synchronization step of claim 13. Additionally, Odgen does not teach or suggest the elements missing from Mirashrafi and the combination of the references cannot anticipate the claim. Further, claims 14-16 depend on claim 13 and are allowable based on the same reasoning above. Applicants respectfully request that the rejection be withdrawn.

In Response, applicant definition in the specification is an example and therefore not limiting. Further, Applicant has supplied no evidence to support, his finding that Mirashrafi is not using the ordinary meaning of the word, synchronization.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

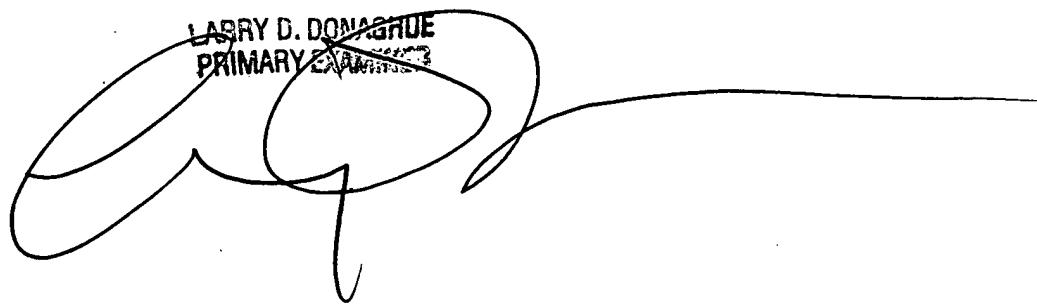
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D. Donaghue whose telephone number is 571-272-3962. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LARRY D. DONAGHUE
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "LARRY D. DONAGHUE", is written over a printed name. The signature is fluid and cursive, with the "L" and "D" being particularly prominent. A long, thin horizontal line extends from the end of the signature to the right.